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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,497	04/02/2007	Reiner Fischer	2400.030000/VLC/CMB	1712
26111 7590 03/03/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER CHU, YONG LIANG				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
03/03/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,497

**Applicant(s)**

FISCHER ET AL.

**Examiner**

YONG CHU

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7 and 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☒ Claim(s) 1-5 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date 02/23/2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

Claims 1-19 are pending in the instant application.

### ***Information Disclosure Statement***

Applicants' Information Disclosure Statement, filed on 02/23/2007 has been considered. Please refer to Applicant's copy of the PTO-1449 submitted herewith.

### ***Priority***

This application is a 371 of PCT/EP2004/12444 filed on 11/04/2004, which claims the benefit of foreign priority of Germany Patent Application No. 103 51 647.6, filed on 11/05/2003.

### ***Response to Restriction***

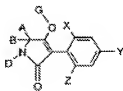
Applicants' election with traverse of Groups I (i.e. claims 1-5 and 8) drawn to a compound of the formula (I) according to claim 1, with elected species of the compound I-a-4 on page 94 of the specification in the reply filed on 12/03/2008 is acknowledged. Applicant's argument over lack of unity of the application has been considered, but found not persuasive, because the previously cited WO2001/017973, and reference cited instantly render the instant inventions lack unity of invention. Therefore, the restriction requirement is maintained, and made FINAL.

***Status of the Claims***

Claims 6-7 and 9-19 are withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR 1.142(b) due to the restriction requirement.

**Provisionally Elected and Examined Subject Matter**

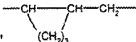
The scope of the invention of the provisionally elected and the examined subject matter is as follows:



A compound of the formula (I) according to the elected species, wherein: **X** is halogen; **Y** is alkyl; **Z** is C<sub>2</sub>-C<sub>6</sub>-alkyl; **G** is hydrogen; **A** is hydrogen, or C<sub>2</sub>-C<sub>8</sub>-alkyl; **B** is hydrogen or alkyl; **D** is H or optionally substituted cycloalkyl; or pesticides and/or herbicides, comprising at least one compound of the formula (I) according to claim 1.

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 1-5 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds and compositions contain varying functional groups which are chemically recognized to differ in structure, function, and reactivity. The scope of the invention is set in considering the elected species and the preferred embodiments. Therefore, claims 1-5 and 8 (in part) will be examined on the merits.

### ***Specification***

The specification contains errors at pages 30, 94, 99, and 103 on the definition of substituents **D** and **A**. Specifically, the structure "" occupied the space of both substituents **A** and **D**, and the structure is a linker with an open bond at the both end, which seems not make much sense to an organic chemist, because substituent **D** is not a linker, and should not be an open bond at the both ends.

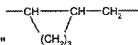
### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the elected species of the compound I-

a-4 is indefinite because the definition of **A** and **D** at the table on page 94 of the



specification is not clear, because the structure " occupied the space of both substituents **A** and **D**. The substituents **A** and **D** are interpreted as **A** is hydrogen, or C<sub>2</sub>-C<sub>8</sub>-alkyl; **B** is hydrogen or alkyl; **D** is H or optionally substituted cycloalkyl. Moreover, the structure should not have an open bond at the both ends.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

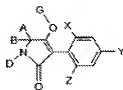
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 and 8 are rejected under 35 U.S.C. 103 (a) as unpatentable over U.S. Patent No. 6,469,196 ("the '196 patent") by Lieb et al.

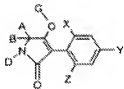
Applicant's instantly elected invention of claims 1-5, and 14 are drawn to a



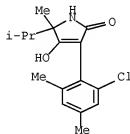
compound of the formula (I) according to the elected species, wherein: **X** is halogen; **Y** is alkyl; **Z** is C<sub>2</sub>-C<sub>6</sub>-alkyl; **G** is hydrogen; **A** is hydrogen, or C<sub>2</sub>-C<sub>8</sub>-alkyl; **B** is hydrogen or alkyl; **D** is hydrogen or optionally substituted cycloalkyl; or pesticides and/or herbicides, comprising at least one compound of the formula (I) according to claim 1.

Determination of the scope and content of the prior art (MPEP §2141.01)

The '196 patent teaches pesticides and/or herbicides of compound



with a specific compound



(CAS RN 186746-

85-0) disclosed in TABLE 1, lines 19-20, and 22-23, column 38, wherein **X** is halogen; **Y** is alkyl; **Z** is C<sub>1</sub>-alkyl; **G** is hydrogen; **A** is iso-propyl; **B** is alkyl (i.e. -CH<sub>3</sub>); **D** is hydrogen, or optionally substituted cycloalkyl; or pesticides and/or herbicides, comprising at least one compound of claim 1.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the '196 compounds and the instantly claimed compound is the substituents **Z**, methyl group for the prior art, and C<sub>2</sub>-C<sub>6</sub>-alkyl group for the instantly claimed invention.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

The instantly claimed compounds would have been obvious over the prior art teachings. It is because the prior art teaches herbicides and/or pesticides, which is the same utility as the instantly claimed compounds. The only difference is methyl group over C<sub>2</sub>-C<sub>6</sub>-alkyl group. The said compounds are the instantly claimed compound are homologue differed by -(CH<sub>2</sub>)- unit. To those skilled in the chemical art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members, In re Wilder, 563 F.2d 457, 195USPQ 426 (CCPA 1977), and MPEP§2144.09. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity. Therefore, the instantly claimed compounds would have been suggested to one skilled in the

In addition, the Examiner would like also to draw Applicants' attention on the other compounds in the '196 patent, which maybe renders the expanded scope of the subject matter unpatentable.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the



unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6, and 8 of U.S. Patent No. 5,994,274 ("the '274 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed scope between instant claims 1-6 and 8 and claims 1-4, 6, and 8 of the '274 patent are overlapped, and the compound (CAS RN 186746-85-0) disclosed in the '274 patent read on both claims. Therefore, instant claims 1-5 and 8 have been double patented by claims 1-4, 6, and 8 of the '274 patent.

### ***Claim Objection***

Claims 1-5 and 8 are provisionally objected to for containing elected and non-elected subject matter. The elected subject matter has been identified supra.

***Conclusion***

- Claims 1-5 and 8 are objected to.
- Claims 1-5 and 8 are rejected.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached between 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Status Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

